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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/713,429

11/17/2003

Kelly E. Rollin

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11/03/2006

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EXAMINER

LEROUX, ETIENNE PIERRE

ART UNIT

PAPER NUMBER

2161

DATE MAILED: 11/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/713,429

Applicant(s)

ROLLIN ET AL.

Examiner

Etienne P. LeRoux

Art Unit

2161

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-63 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-63 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

Claim Status

Claims 1-63 are pending. Claims 1-63 are rejected as detailed below.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites “detecting changes to the user profile data and storing the modified user profile data back to the PSD without explicit action from a user.” The scope of the invention cannot be determined because it is unclear which method step(s) require explicit user actions and which method steps do not require explicit user actions. Particularly, are (1) detecting changes, and/or (2) storing the modified user profile performed without explicit action from the user. Furthermore, the metes and bounds of the claimed invention is not ascertainable because the difference if any, between user actions and explicit user actions is not explained in the specification. In fact the word “explicit” does not appear in the specification at all. For purposes, of this first action on the merits, patentable weight will not be given to “explicit action from a user.”

Claim 1 recites “storing the modified user profile.” There is insufficient antecedent basis for “the modified user profile.”

Claims 2-9 are rejected, at least, for being dependent from a rejected base claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 5-7, 9, 10, 14-16 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Pub No US 2002/0135613 issued to O'Hara, as best examiner is able to ascertain.

Claims 1, 5-7, 9, 10, 14-16 and 18:

O'Hara discloses:

upon detecting a connection of a Portable Storage Device (PSD) to a computing device reading user profile data from the PSD

using the user profile data to configure the computing device

detecting changes to the user profile data and storing the modified user profile data back to the PSD without explicit action from a user [abstract, Fig 3, Fig 4, paragraphs 6, 10, 15, 18, 19, 21, and 26].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2161

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 3, 4, 8, 11-13 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Hara in view of Pub No 2004/0268148 issued to Karjala et al (hereafter Karjala), as best examiner is able to ascertain

Claims 2 and 11:

O'Hara discloses the elements of claim 1 as noted above but does not disclose wherein the PSD connects to the computing device through a wireless connection. Karjala discloses wherein the PSD connects to the computing device through a wireless connection [Fig 1, 12]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify O'Hara to include wherein the PSD connects to the computing device through a wireless connection as taught by Karjala for the purpose of making the portable device independent of a wire connection.

Claims 4 and 13:

The combination of O'Hara and Karjala discloses the elements of claim 1 as noted above and furthermore, Karjala discloses a smart device [mobile device 10, Fig 1]

Claims 8 and 17:

The combination of O'Hara and Karjala discloses the elements of claim 1 as noted above and furthermore, Karjala discloses wherein the storing step occurs in direct response to the modification of the user profile data [paragraph 37]

Art Unit: 2161

Claims 3 and 12:

The combination of O'Hara and Karjala discloses the elements of claim 1/10 as noted above and furthermore, O'Hara discloses a dumb device [paragraph 15]

Rejection of claims 19-63 can be made on the same basis as above claim rejections.

Response to Arguments

Applicant's arguments filed 9/25/2006 are moot based on above new grounds of rejection.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Etienne P. LeRoux whose telephone number is (571) 272-4022.

The examiner can normally be reached Monday through Friday, 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin can be reached on (571) 272-4146. The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

Art Unit: 2161

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Etienne LeRoux

11/1/2006

Handwritten signature of Etienne LeRoux in cursive script.

Primary Examiner